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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,735	10/25/2000	Glynis Allicia Walton	KCC-13,406.1	2992
35844	7590	12/16/2003	EXAMINER	
PAULEY PETERSEN KINNE & ERICKSON			VO, HAI	
2800 WEST HIGGINS ROAD			ART UNIT	
SUITE 365			PAPER NUMBER	
HOFFMAN ESTATES, IL 60195			1771	

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/696,735

**Applicant(s)**

WALTON ET AL.

**Examiner**

Hai Vo

**Art Unit**

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0917.                      6) ☐ Other: \_\_\_\_\_

1. Claims 1-61 have been canceled in the amendment received on 09/08/2003.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 62-69, and 72 are rejected under 35 U.S.C. 102(e) as being anticipated by McCormack et al (US 6,015,764). McCormack teaches a breathable, stretch-thinned elastic film comprising an elastomeric polymer and 45 to 60 wt% inorganic filler particles (column 5, lines 50-52, column 6, lines 10-15). McCormack discloses the elastomeric polymer including a styrene block copolymer elastomer and a metallocene catalyzed polyolefin elastomer (column 3, lines 5-10, 47-50, claim 1). The film has a water vapor transmission rate of at least 1000 grams/m<sup>2</sup>/24hours (column 6, lines 7-8). The styrene block copolymer elastomer comprises a diblock copolymer (column 3, lines 11-12) and a tetrablock copolymer (claim 5). The ethylene-alpha olefin copolymer is ethylene 1-octene having a density of 0.870 g/cc (table 1). The filler particles comprise calcium carbonate (table 1). It is the examiner's position that McCormack anticipates the claimed subject matter.

The arguments that US 6,015,764 fails to teach the claimed subject matter as required by claims 62 and 63 are not found persuasive. US 6,015,764 to McCormack teaches the film including both of the elastomer combined together (column 3, lines 5-10, 47-50, claim 1). Applicants argue that McCormack does not distinguish between high and low performance elastomer, does not disclose that they have different properties and does not recognize a benefit from using them together. The arguments are not found persuasive. It appears that McCormack and Applicants are using the similar elastomeric materials to form an elastic film, i.e., a blend of a styrene block copolymer and, a metallocene catalyzed polyolefin having the same density. Likewise, it is apparent that the two elastomers would have different properties. Products of different chemical composition must have different properties. Further, the claims are specific about the water vapor transmission rate, the benefit from using these two elastomeric polymers together. The film of McCormack has the WVTR within the claimed range. Again, it is not understood that McCormack does not recognize the benefit from using them together.

4. Claims 62-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Brady et al (US 6,258,308). Brady teaches a breathable, stretch-thinned elastic film comprising a metallocene catalyzed ethylene copolymer having a density lower than 0.9 g/cm<sup>3</sup> (column 8, lines 1-13), a styrene block copolymer (column 8, lines 55-65), and inorganic particle fillers (column 10, line 34). Brady discloses the styrene block copolymer elastomer being a diblock and a tetrablock copolymer

(column 9, lines 36-40). The film has a water vapor transmission rate of at least 1000 grams/m<sup>2</sup>/24hours (table 9). The filler particles comprise calcium carbonate (table 4). The film comprises about 1.4 to 25 wt% of styrene block copolymer (column 8, lines 64-67), 30 wt% of polyolefin (tables 4 and 5), and 30-70 wt% of filler particles (column 10, lines 15-17, tables 4 and 5) within the claimed ranges. It is the examiner's position that Brady anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 70, 71 and 73 are rejected under 35 U.S.C. 103(a) as being obvious over McCormack et al (US 6,015,764) in view of Brady et al (US 6,258,308). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter

disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

McCormack does not specifically disclose the amounts of polyolefin and styrene block copolymer being used in the elastic film. Therefore, it is necessary and thus obvious for the skilled artisan to look to the prior art for the suitable amounts of these components. Brady teaches a breathable, stretch-thinned elastic film comprising a metallocene catalyzed ethylene copolymer having a density lower than 0.9 g/cm<sup>3</sup> (column 8, lines 1-13), a styrene block copolymer (column 8, lines 55-65), and inorganic particle fillers (column 10, line 34). Brady discloses the film comprising about 1.4 to 25 wt% of styrene block copolymer (column 8, lines 64-67), 30 wt% of polyolefin (tables 4 and 5) and having the WVTR similar to the film of McCormack. In the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the polyolefin and styrene block copolymer with

the amounts instantly claimed, motivated by Brady and expectation of successfully practicing the invention of McCormack. Such is also taught by the prior art to provide the film having improved elastic behavior (Brady, US 6,258,308, column 9, lines 4-5), which is important to the invention of McCormack, thus further suggesting the modification.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 62, 63, 66-68, and 70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,479,154 in view of Erderly et al (US 5,451,450). Claims 1-11 of U.S. Patent No. 6,479,154 teaches every and each element of the presently claimed subject matter except a density of the low performance polyethylene elastomer. Claims 1-11 of U.S. Patent No. 6,479,154 does not specifically disclose the low performance polyethylene elastomer being prepared in the

presence of metallocene catalyst. Erderly teaches an elastic film comprising the metallocene catalyzed polyolefin having a density within the claimed range (column 7, lines 10-15) to provide the elastic film with improved orientability and strength (column 8, lines 13-15), which is important to the invention of US Patent No. 6,479,154 and thus suggesting the modification. Erderly discloses the low performance elastomer comprising ethylene/1-octene (column 3, lines 45-48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the metallocene catalyzed polyolefin having a density within the range instantly claimed motivated by the desire to provide the elastic film with improved orientability and strength.

#### ***Response to Arguments***

9. The art rejections over McCormack (US 5,695,868) and WO 99/47590 have been overcome by the present amendment and response (see pages 9 and 10 of the amendment filed on 09/08/2003).
10. Applicant's arguments with respect to claims 62-73 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

Hai Vo  
TC 1700